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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,042	06/19/2003	John F. Casey	10030748-1	8468

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AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

EXAMINER

CHEN, ERIC BRICE

ART UNIT PAPER NUMBER

1765

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/601,042

Applicant(s)

CASEY ET AL.

Examiner

Eric B. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-2, 4, 6, 9, 12-14, 16 and 19-20 is/are allowed.
- 6) ☒ Claim(s) 3, 5, 7, 8, 10, 11, 15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 7, 8, 10, 11, 15, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/12/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/12/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 5, 7-8, 10-11, 15, and 17-18 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 3 contains the trademark/trade name DU PONT QG150. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a conductive gold material and, accordingly, the identification/description is indefinite.

4. Claims 5, 8, 11, and 15 contain the trademark/trade name KQ CL-90-7858. In the present case, the trademark/trade name is used to identify/describe a glass dielectric and, accordingly, the identification/description is indefinite.

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5. Claims 7-8, 10, and 17 contain the trademark/trade name KQ. In the present case, the trademark/trade name is used to identify/describe a dielectric and, accordingly, the identification/description is indefinite.

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the claim is dependent on indefinite base claim 7.

7. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the claim is dependent on indefinite base claim 10.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the claim is dependent on indefinite base claim 17.

***Allowable Subject Matter***

9. Claims 3, 5, 7-8, 10-11, 15, and 17-18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 1-2, 4, 6, 9, 12-14, 16, and 19-20 are allowed.

11. The following is an examiner's statement of reasons for allowance: the prior art fails to teach or suggest subsintering the conductive thickfilm. The closes prior art, Nguyen, discloses a method for forming a conductor on a dielectric, comprising: depositing a conductive thickfilm (12/16/20) on the dielectric (11) (column 6, lines 1-4; Figure 3); firing the at least one conductor (12/16/20) at a full sintering temperature (column 8, lines 56-64); patterning the conductive thickfilm (12/16/20) (Figure 3) to

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define at least one conductor (20) (column 8, lines 66-68; column 9, lines 1-3); etching the conductive thickfilm (12) to expose the at least one conductor (20) (Figure 3).

However, there is no motivation or suggestion of subsintering the conductive thickfilm, as in the context of claim 1.

12. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Terminal Disclaimer***

13. The terminal disclaimer filed on May 12, 2005, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/600,143, filed June 19, 200, has been reviewed and is accepted.

The terminal disclaimer has been recorded.

#### ***Response to Arguments***

14. In view of Applicants' submission of a Corrected Drawing Sheet (Figures 1 and 2) and Applicants' Amendments to the Specification, filed May 12, 2005, the objection to the Drawings have been withdrawn.

15. Applicants' arguments (Applicants' Remarks, pages 4-7) regarding the rejection of claims 3, 5, 7-8, 10-11, 15, and 17-18 under 35 U.S.C. 112, second paragraph, have been fully considered but they are not persuasive. Applicants' arguments regarding the

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use of trademarks in the claims and case law citations have been noted (Applicants' Remarks, pages 4-7). However, the formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. A trademark or trade name is used to identify a source of goods, and not the goods themselves. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product.

16. In view of the Applicants' Terminal Disclaimer, filed May 12, 2005, the provisional rejection of claims 1, 2, 4, and 20 under the judicially created doctrine of double-patenting has been withdrawn.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Chen whose telephone number is (571) 272-2947. The examiner can normally be reached on Monday through Friday, 8AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine G. Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBC

July 7, 2005

*EBC*

**NADINE G. NORTON**  
**SUPERVISORY PATENT EXAMINER**

*Nadine G. Norton*